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EXAMINER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID L. BATES, JEROME B. GORDON, and
DONALD J. GOODENOW

Appeal 2008-1462
Application 09/579,407
Technology Center 3600

Decided: June 26, 2008

Before LINDA E. HORNER, DAVID B. WALKER and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

David L. Bates et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1 through 24. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We reverse.

The Appellants' claimed invention relates to a method for generating an insurance quote for a customer using information obtained from a lender's database that was provided by a customer on a loan application and underwriting the insurance for the item intended to be purchased by the loan. (Spec. 2:22-26). Claim 1, reproduced below, is representative of the subject matter on appeal.

> 1. A method of generating an insurance quote for an applicant for a loan from a lender, wherein the loan is intended to fund the purchase of an item, comprising the steps of:
>
> determining the acceptability of the loan;
>
> obtaining data from a lender's database, wherein at least a portion of the data in the database is provided to the lender by the applicant in connection with obtaining the loan from the lender;
>
> automatically underwriting an insurance risk for the item intended to be purchased using the loan;
>
> generating the insurance quote utilizing the data obtained from the lender's database, the insurance quote is for the provision of insurance to cover the item intended to be purchased using the loan; and
>
> advising the applicant of the acceptability of the loan and providing the insurance quote to the applicant contemporaneously with the advising step if the loan has been accepted.

The Appellants seek our review of the Examiner's rejections under 35 U.S.C. § 103(a) of:

1) claims 1, 3-9, 11, 13-18, 20, and 22-23 as unpatentable over U.S. Patent No. 5,537,315, issued July 16, 1996 to Mitcham and U.S. Patent No. 5,239,462, issued August 24, 1993 to Jones.

2) claims 2, 12, and 21 as unpatentable over Mitcham, Jones, and U.S. Patent No. 6,263,320 B1, issued July 17, 2001 to Danilunas.

3) claims 10, 19, and 24 as unpatentable over Mitcham, Jones, and an article by Christine Dugas entitled "Not The Total Solution Bankruptcy Stays On Credit Reports," August 9, 1996.

The Examiner and the Appellants agree that Mitcham does not describe obtaining data from a lender's database and using this data to underwrite an insurance risk for the item to be purchased by the loan. (Ans. 3 and App. Br. 10.) The Examiner found Jones teaches during a method of determining the approval status of a loan and sending the applicant's data to an insurance provider to permit follow-up with the potential borrower. (Ans. 3.) The Appellants contend: 1) nothing in Mitcham contemplates using loan application data to generate an insurance quote and 2) while conceding that Jones does teach that the lender advises various lead organizations, such as insurance companies, that the potential borrower is considering a loan to purchase an item, Jones does not teach any action other than referral. (App. Br. 12-13.) We agree with the Appellant and disagree with the Examiner's finding as to Jones sending the applicant's data during the method of approval.

It is clear that Mitcham describes a very specific method for generation of an insurance quote requiring the potential insured to input a long list of necessary items in order for the system to generate the insurance quote. (Mitcham, col. 5, ll. 12-43.) Likewise, it is clear that Jones describes giving notice to real estate insurance companies of a borrower's interest in purchasing a product, i.e., a home. (Jones, col. 7, ll. 40-45.) While Jones describes giving notice, Jones does not describe that within this notice data from the lender's database is being used or sent. At most, what reasonably can be inferred from the description in Jones is that the lead organizations will have received a "lead" or "tip" to contact the borrower about products or services the lead organization sells or provides. Moreover, neither Mitcham nor Jones describes the step of automatically underwriting the insurance risk for the item intended to be purchased using the loan. The Danilunas and Dugas references used by the Examiner do not cure the deficiencies of Mitcham and Jones.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Because we disagree with the Examiner's finding as to the scope and content of Jones, we find that the Examiner has failed to set forth a prima facie case of obviousness, and we will not sustain the rejection of claims 1, 3-9, 11, 13-18, 20, and 22-23 as unpatentable over Mitcham and Jones. For the same reasons, we will not sustain the rejections of: claims 2, 12, and 21 as unpatentable over Mitcham, Jones, and Danilunas

and claims 10, 19, and 24 as unpatentable over Mitcham, Jones, and the article by Dugas.

CONCLUSIONS

We conclude that the Appellants have shown the Examiner erred in rejecting under 35 U.S.C. § 103(a): (1) claims 1, 3-9, 11, 13-18, 20, and 22-23 as unpatentable over Mitcham and Jones; (2) claims 2, 12, and 21 as unpatentable over Mitcham, Jones, and Danilunas; and (3) claims 10, 19, and 24 as unpatentable over Mitcham, Jones, and Dugas.

DECISION

The decision of the Examiner to reject claims 1 through 24 is reversed.

REVERSED

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